

REMARKS/ARGUMENTS

Claims 1-25 are pending in the application. Claims 1-25 are rejected.

Rejections under 35 USC § 103

Claims 1-8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl (U.S. Patent 4,987,597) in view of Williams (US 5,573,015) and further in view of Adams (US 5,488,961). Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl (U.S. Patent 4,987,597) in view of Williams (US 5,573,015). The remainder of the claims are rejected over Haertl in view of Williams and in view of several other cited references described in the office action. These rejections are respectfully traversed.

At the outset, Applicants note that the Examiner has indicated that applicants arguments in the response of 1/25/06 were persuasive with respect to the deficiencies of the cited art from the office action of 10/26/05. Applicants wish to point out those same arguments are directly applicable to the current rejections in that then, as now, the Examiner relies on the Haertl reference in making the rejections. Accordingly, Applicants respectfully submit that withdrawal of all rejection is warranted in view of the Examiner's prior findings in withdrawing the previous rejections.

Applicants respectfully traverse all of the above rejections as none of the cited art alone or in combination teaches or reasonably suggests multiple elements of the claimed invention of independent claims 1, 13 and 25 and therefore their respective dependant claims. In fact, Haertl actually teaches away the claimed invention in several respects described below. Applicants respectfully point that the courts have held that an obviousness rejection is improper when the combination of references teaches away from the claimed invention (See In re Gurley, 27 F.3d 551, 553, 31 (Fed. Cir. 1994).

Haertl is "directed to an apparatus for closing an opening of a hearing aid or an ear adaptor for a hearing aid" (Haertl, Col 1, lines 7-10; See also the Abstract) and not to an "

intracanal shield shaped and dimensioned to be laterally positioned with respect to said hearing device, so that said intracanal shield **caps the cavity of said ear canal** " as is recited in independent claim 13 (emphasis added). Claims 1 and 25 recite similar limitations. Haertl teaches away from a cap intended to cap "the cavity of the ear canal", since to perform Haertl's intended function of capping an opening on an "in-the-ear hearing aid" (See Haertl Col 2, lines 58-60)) the perimeter of Haertl 's cap is necessarily much smaller than the perimeter of the ear canal. In other words, Haertl's cap can't be sized and dimensioned to fit in two places at once and still perform its intended function of capping an opening on a hearing aid. Applicants respectfully point out that the Federal Circuit has held there is no suggestion or motivation to make a modification in a prior art device if the modification would render the device unsatisfactory for its intended purpose (See *In re Gordon*, 733 F.2d 900 (Fed Cir. 1984); See also the M.P.E.P. § 2143.01). Accordingly, on this basis alone, Applicants respectfully request withdrawal of the rejection.

In addition to the above deficiency, Haertl also teaches away from "a conforming perimeter for fitting in a retaining manner along the cross sectional wall of the ear canal" as is recited in claim 13. Claim 25 recites a similar limitation. As described above, Haertl's cap is intended to fit over and cap an opening on an in-the-ear hearing aid and not to be retained in the ear canal so as to cap the cavity of the ear canal. These two functions are in effect, mutually exclusive given the small size of the opening on the Haertl's hearing aid in relation to the perimeter of the ear canal. Haertl further teaches away from a conformable perimeter in that Haertl teaches that its cap is sufficiently rigid to screw or snap onto an opening of the hearing aid. See Haertl, Col 3, lines 5-10. Thus, Haertl's cap can not on the one hand be rigid, and on the other, be modified to conform. In addition to being mutually exclusive with a rigid cap, a conformable cap would preclude Haertl from performing its intended function of capping the opening on the hearing aid. Accordingly on this separate and additional basis, Applicants respectfully request withdrawal of the rejection of claims 13, and 25 and their respective dependant claims.

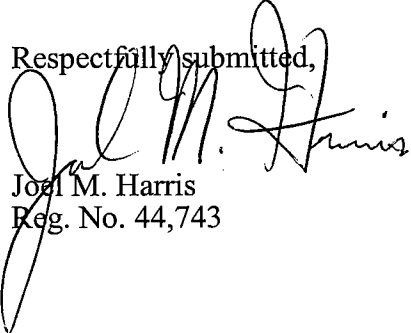
In regard to the rejection of the dependant claims , these are traversed in that: 1) none of the remaining cited references compensates for the deficiencies of Haertl described above; and 2) also as described above, Haertl teaches away from the claimed invention in multiple respects an thus an obviousness rejection is improper under the holding from In re Gurley. Accordingly, withdrawal of these rejections is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

It is believed that no fees are due with this response; however, should any fees be required under 37 C.F.R. § 1.16 to 1.21 for any reason, the Commissioner is authorized to charge Deposit Account No 20-1430. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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